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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/400,812	09/22/99	MCSELFRESH	P 304-15027-US

IM62/1103

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EXAMINER

TUCKER, P

ART UNIT	PAPER NUMBER
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1712

10

DATE MAILED: 11/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

400812

Applicant(s)

McELFRESH

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/9/00
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4, 6-10, 13, 14, 16-18 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 4, 6-10, 13, 14, 16-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claim Objections

1. Claims 6 and 10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 6 and 10 fail to further limit the parent claims, since tallow amidopropyl amine oxide does not contain R' groups as alkyl groups, but as hydrogen. It is noted that applicants deleted a portion of their specification to correct the implication that they did possess alkyl groups..

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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3. Claims 1, 4, 7, 8-10, 13, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 99/32572.

WO '572 teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). Proppants and breakers may be added (see page 11, line 18 to page 12, line 9). The present invention is thus anticipated by WO '572.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6, 10, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/32572.

WO '572 teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). Proppants and breakers may be added (see page 11, line 18 to

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page 12, line 9). WO '572 differs from the present invention in not specifically teaching the use of tallow amido propyl amine oxide as an amine oxide useful in the invention. WO '572 however teaches the use of Tallow amido propyl dimethylamine oxide in the drilling and treating fluids (example 8). As homologues and analogues with such similar structures would be expected to have similar properties and utility, it would be obvious to one of ordinary skill in the art to utilize various homologues and analogues of the amine oxides disclosed by WO '572, including the tallow amido propyl amine oxide of the present invention, since such homologues and analogues would be expected to be useful in the viscoelastic well fluids of WO '572.

6. Applicants amendment distinguishes over the art of Llave. Applicants other arguments have been considered but are not deemed persuasive. Applicants have argued that WO '572 does not teach R' as an alkyl group averaging 1-3 carbon atoms. This is incorrect, since the dimethyl amine of example 8 of WO '572 clearly teaches methyl groups having 1 carbon atom.

Furthermore, contrary to applicants arguments, in addition to teaching an example using only a single amine oxide as the gelling agent, the specification at page 4, lines 17-19 clearly teach that a single gelling agent may be used. The WO '572 thus clearly anticipates the present rejected claims. In addition, the courts have held that homologues produced by the substitution of two methyl groups for two hydrogen atoms (each differing by CH₂), would obviously have similar utility to one of ordinary skill in the art, absent a showing of superior and unexpected results (Ex

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parte Faque 121 USPQ 425). Thus the Tallow amido propyl dimethylamine oxide disclosed by WO '572 would clearly render the tallow amido propyl amine oxide of the present invention for use in gelling subterranean fluids, obvious to one of ordinary skill in the art, absent a showing of superior and unexpected results.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson

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may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2142
November 2, 2000


PHILIP C. TUCKER
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